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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/766,550

01/28/2004

David Robison

CRS / 278

3112

26875

7590

10/17/2006

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EXAMINER

A, PHI DIEU TRAN

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,550

Applicant(s)

ROBISON ET AL.

Examiner

Phi D. A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/26/06 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5-6, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Leeuwenburgh (5935669).

Leeuwenburgh shows a method of rolling a membrane sheeting having a seam tape (16) applied only along a first edge of the membrane sheeting with a portion of the membrane sheeting having no seam tap, the portion (14) extending from the seam tape to a second edge, the membrane having a thickness greater than or equal to a thickness of the seam tape (col 1 lines 61-63 states that the combined thickness of the tape and cover strip being at least about equal to the total thickness of all folding layers, and col 1 lines 6-8 discloses the covering sheet being folded at least two folding layers (2 layers included), and as the cover being two layers and having thickness equal to the combined thickness of the tape and the cover strip, it goes that the cover strip and the tape are of equal thickness in this embodiment, and applicant also discloses using varying thickness for the tape/covering strip), comprising folding the portion of the membrane sheeting over upon itself only once (for the embodiment when there are only two folding layers, each layer being the top or the bottom layer) to form a folded sheet wherein the portion of sheeting does not overlie any area of the membrane sheeting having seam tape

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adhered thereto (figures 1, 3), rolling the membrane sheeting (col 2 lines 30-34), the seam tape is on a first surface of the membrane sheeting and the portion of the membrane sheeting is folded onto the first surface (col 2-3, lines 65-2 discloses the different possible location of the fold and the tape), the seam tape is on a first surface of the membrane sheeting and the portion of the membrane sheeting is folded onto a second surface of the membrane sheeting, the sheeting having a first edge and a second edge, the portion of the membrane is folded toward the first edge with the second edge of the sheeting resting adjacent the seam tap (figure 3), transporting the roll of sheeting to a job site, unrolling the membrane sheeting and adhering the seam tape to an edge of an adjacent membrane sheet (inherently so as the roll of covering has to arrive at the job site/wherever that might be, and unroll to attach to doors, windows which have planar sheet).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leeuwenburgh (5935669) in view of Cox et al (5654055).

Leeuwenburgh shows all the claimed limitation except for the membrane sheeting being EPDM.

Cox et al discloses backing sheeting being made of a variety of plastics including EPDM (col 6 lines 47-62).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Leeuwenburgh's structure to show the membrane sheeting being EPDM because it would provide a balance between compliance and clean removal as taught by Cox et al.

5. Claims 1, 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuoriniemi (6444307) in view of Kreckel (5747131).

Tuoriniemi (figure 5b) shows a method of rolling a membrane sheeting having a seam adhesive (22b) applied only along a first edge of the membrane sheeting with a portion of the membrane sheeting having no seam tap, the portion (14) extending from the seam adhesive to a second edge, the membrane (20) having a thickness greater than or equal to a thickness of the seam adhesive, comprising folding the portion of the membrane sheeting over upon itself only once to form a folded sheet wherein the portion of sheeting does not overlie any area of the membrane sheeting having seam adhesive adhered thereto (figure 5b), rolling the membrane sheeting (figure 6a), the seam adhesive is on a first surface of the membrane sheeting and the portion of the membrane sheeting is folded onto a second surface of the membrane sheeting, the membrane sheeting is EPDM (col 7 line 39), the roll of membrane having the second edge being folded toward the first edge and wherein the second edge does not overlie the seam adhesive, the portion of the membrane is folded toward the first edge with the second edge of the sheeting resting adjacent (closely next to) to the seam adhesive, the seam adhesive does not extend beyond the first edge of the membrane sheeting, transporting the roll of sheeting to a job site, unrolling the membrane sheeting and adhering the seam adhesive to an edge of an adjacent

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membrane sheet (inherently so as the roll of covering has to arrive at the job site/wherever that might be, and unroll to attach to doors, windows which have planar sheet).

Tuoriniemi does not show the seam adhesive being seam tape.

Kreckel discloses a double side adhesive seam tape (2) attaching to a membrane (1) to enable the easy attachment of the membrane to another structure.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Tuoriniemi's structure to show the seam adhesive being seam tape because a double sided adhesive seam tape would provide for good adhering of the inside of the covering to a window surface while leaving the outer surface to properly cover the protected area as taught by Kreckel; furthermore, examiner takes Official Notice of the well known equivalence of using a strip of adhesive or a double sided tape to form an adhesive means for a covering structure as they both function the same to provide a means for bonding the covering structure to another surface.

6. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuoriniemi (6444307) in view of Kreckel (5747131).

Tuoriniemi (figure 11f) shows a method of rolling a membrane sheeting having a seam adhesive (22b) applied only along a first edge of the membrane sheeting with a portion of the membrane sheeting having no seam tap, the portion (30) extending from the seam adhesive to a second edge, the membrane (30) having a thickness greater than or equal to a thickness of the seam adhesive, comprising folding the portion of the membrane sheeting over upon itself only once to form a folded sheet wherein the portion of sheeting does not overlies any area of the membrane sheeting having seam adhesive adhered thereto (figure 11f), rolling the membrane

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sheeting (figure 6a), the seam adhesive is on a first surface of the membrane sheeting and the portion of the membrane sheeting is folded onto a first surface of the membrane sheeting (the folding of part 30 per the folding at 50b onto the first surface touched by adhesive 22b).

Tuoriniemi does not show the seam adhesive being seam tape.

Kreckel discloses a double side adhesive seam tape (2) attaching to a membrane (1) to enable the easy attachment of the membrane to another structure.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Tuoriniemi's structure to show the seam adhesive being seam tape because a double sided adhesive seam tape would provide for good adhering of the inside of the covering to a window surface while leaving the outer surface to properly cover the protected area as taught by Kreckel; furthermore, examiner takes Official Notice of the well known equivalence of using a strip of adhesive or a double sided tape to form an adhesive means for a covering structure as they both function the same to provide a means for bonding the covering structure to another surface.

Response to Arguments

7. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

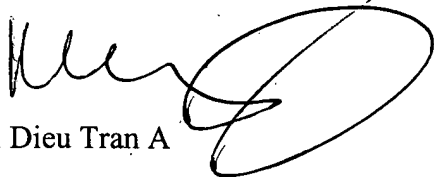
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different masking tape designs.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Phi Dieu Tran A', with a large, stylized circular flourish at the end.

Phi Dieu Tran A

10/13/06